

REMARKS

At the time of the Office Action dated March 13, 2003, claims 1-20 were pending. Of those claims, claim 1, 2, 19 and 20 have been rejected, and claims 5-18 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b).

Applicant acknowledges, with appreciation, the Examiner's indication that claims 3 and 4 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In this Amendment, claim 3 has been amended to place it in independent form based on claims 1 and 2. Therefore, claims 3 and 4 are now in condition for allowance.

Moreover, claims 1, 2 and 19 has been cancelled, and cosmetic amendment has been made to claims 3, 4 and 20 in this Amendment. Care has been exercised to avoid the introduction of new matter.

In the first enumerated paragraph of the Office Action, it is stated that "Applicant's response to the restriction requirement filed on 2/13/03...." However, the correct filing date of the response is February 12, 2003. Applicant respectfully requests the Examiner to make a correction to the filing date of the response.

Specification Objections.

The abstract of the disclosure has been objected to because it uses language which can be implied, i.e., "according to the invention." In response, Applicant has amended the abstract to delete "according to the invention," as attached. Accordingly, withdrawal of the objections to the abstract is respectfully solicited.

The Examiner also objected to the disclosure because the summary of invention section and its header are missing. Applicant respectfully traverses this objection.

Applicant submits that this application has been filed through PCT route and is completely consistent with PCT Rule 5.1. PCT Rule 5.1 provides that "(a) The description... shall: (iii) disclose the invention, as claimed, in such terms that the technical problem... and its solution can be understood..." PCT Administrative Instruction Section 204 also stipulates that "The headings of the parts of the description should be as follows: (iii) for matter referred to in Rule 5.1(a)(iii), 'Disclosure of Invention.'" Applicant emphasizes that the specification clearly has the heading "Disclosure of the Invention" at page 4, line 21, and discloses the invention from page 4, line 20 to page 12, lines 33, in a manner consistent with PCT Rule.

The PCT regulates in detail the formal requirements that any international application must comply with. It is submitted that requesting Applicants to change an application format which fully complies with PCT Rule, contradicts the spirit of PTC and thus is not acceptable. Therefore, withdrawal of the objections to the specification is respectfully solicited.

Claim Objections.

Claims 19 and 20 have been objected to because of the informalities. Applicant notes that the objection to claim 19 has been rendered moot by cancellation of the claim.

In response, claim 20 has been amended in a manner consistent with the Examiner's suggestions, i.e., "a control signal" and "a capacitor" have been changed to --

said control signal-- and --said capacitor--, respectively. Accordingly, withdrawal of the objections to claims is respectfully solicited.

Claims 1, 2, 19 and 20 have been rejected under 35 U.S.C. §102(e) as being anticipated by Duffy et al.

In the statement of the rejection, the Examiner asserted that Duffy et al. discloses a circuit 100 shown in Figs. 3 and 4 identically corresponding to what is claimed. This rejection is respectfully traversed. Applicant notes that the rejection of claims 1, 2 and 19 has been rendered moot by cancellation of the claims.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. §102, the Examiner is required to point to "page and line" wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.

Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra. That burden has not been discharged.

Applicant submits that that Duffy et al. does not disclose and the Examiner did not identify the limitation recited in claim 20: "a control circuit controlling said control potential..., based on a potential of a **node between said resistance element and said capacitor**" (emphasis added).

In this respect, the Examiner asserted, "this limitation is met because Duffy's loop filter 110 comprises registers and capacitors, column 3, lines 12-15, clearly there are connections between resistors and capacitors, a potential of one of these nodes reads on the recited potential" (see the ultimate paragraph at page 7 of the Office Action).

Applicant agrees with the Examiner's assertion with respect only to Duffy's loop filter 110 comprising registers and capacitors. However, Applicant notes that Duffy et al. merely shows a "box" as the loop filter 110 (see Fig. 3). Applicant also submits that Duffy et al. discloses "an input 134 [of the common mode control 104] that may receive the signal FILTD" (column 2, lines 64-65), but does **not** disclose an input 134 receives the **signal from a node between a resistance element and a capacitor** as recited in claim 20. This is so because Duffy et al. is **silent** as to the detailed configuration of the loop filter 110, and thus is **silent** on whether a signal is taken from a node between a resistance element and a capacitor in the loop filter 110.

Therefore, Duffy et al. does not identically disclose all the limitations recited in claim 20. Also, the Examiner failed to discharge his burden to identify corresponding elements disclosed in the allegedly anticipating reference. Specifically, the Examiner's assertion "clearly there are connections between resistors and capacitors, a potential of

one of these nodes reads on the recited potential" as to the limitation "control circuit" is baseless. Applicant, therefore, submits that the imposed rejection of claim 20 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Duffy et al. is not factually viable and, hence, solicit withdrawal thereof.

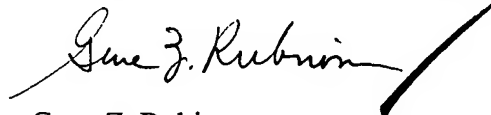
Conclusion.

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, reading "Gene Z. Robinson", followed by a long, sweeping diagonal stroke.

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